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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,608	11/14/2001	Barbara Sheila Goldberg	1223.0050000	7303

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STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1100 NEW YORK AVENUE, N.W., SUITE 600  
WASHINGTON, DC 20005-3934

EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 03/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/936,608**

Applicant(s)  
**Goldberg et al.**

Examiner  
**Kathleen J. Prunner**

Art Unit  
**3751**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 8, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7, and 11-14 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, and 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Jan 8, 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Drawings*

1. The proposed drawing correction filed on January 8, 2003 (Paper No. 12) has been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaguchi et al. (EP 734,722). Yamaguchi et al. disclose an adhesive dispensing arrangement having all the claimed features including a patch (constituted by layer 5) for covering the area to be treated, the patch being provided with an adhesive surface (note line 17 in col. 7) for allowing the patch to stick or adhere to the surface (note lines 31-32 in col. 7), a peelable backing (constituted by layer 2) covering the adhesive surface (note Fig. 1), a discrete dispensing container (constituted by storage layer 4) being located fully between the adhesive surface and the peelable backing and accommodating a substance (note lines 16-24 in col. 4) to be dispensed, an applicator constituted by layer 8 (note Fig. 9) arranged between the patch 5 and the dispensing container 4 and a release agent (constituted by releasable liner layer 6), the dispensing container 4 being positioned to cooperate with the release agent 6, and the release agent 6 being arranged to cause the container 4 to open or rupture on removal of the backing 2 such that the substance is released from the opened or ruptured container 4 onto the applicator 8 which facilitates application of the substance to the area to be treated when the patch 5 is stuck to that area. With respect to claim 11, Yamaguchi et al. also

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disclose that patch and the peelable backing define an outer sealed container within which the dispensing container 4 is housed (note Fig. 1a). With respect to claim 12, Yamaguchi et al. further disclose that the adhesive dispensing arrangement is in the form of a bandage (note lines 16-21 in col. 9) for medical application with the substance being a medicament (note lines 25-59 in col. 4). With regard to claim 13, Yamaguchi et al. additionally discloses that substance is used to treat selected areas (note lines 6-9 in col. 9) and is a drug constituting a chemical treatment (note lines 1-41 in col. 5).

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 3-7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi in view of Sabatano. With respect to claim 3, although Yamaguchi fails to disclose that the applicator includes an absorbent pad, attention is directed to Sabatano who discloses another patch/bandage that uses an applicator which includes at least one absorbent pad 13 secured to the patch 11 along at least one marginal adhering zone with a non-adhering zone (constituted by the top surface thereof as shown in Fig. 2) being interposed between the dispensing container 14 and the backing 22 (note Fig. 2) for receiving the substance 15 to be dispensed from the container 14 after outlet opening 16 is exposed (note lines 20-29 in col. 2). It would have been obvious to one of ordinary skill in the patch/bandage art, at the time the invention was made, to form the applicator of Yamaguchi with an absorbent pad in view of the teachings of Sabatano in order to allow the medication/drug to have a longer residence time in contact with the area to be treated as well as a more cushioning effect over that area for protection. With regard to claim 4, Yamaguchi further discloses that the release agent 6 is adhesively secured to the peelable backing 2 whereby the release

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agent 6 is arranged to be simultaneously peeled away with the backing 2 to rupture or broach the container 4 (note lines 25-31 in col. 7). With regard to claim 5, Yamaguchi additionally discloses that the release agent comprises at least one aperture zone (note Fig. 2) defined in the container 4 and a removable sealing strip 6 for sealing off the aperture with the sealing strip 6 being arranged to expose the aperture on removal thereof. With respect to claim 6, Sabatano further teaches the obviousness of extending the sealing strip between the container and the non-adhered zones of the pad whereby the pad is arranged temporarily to splay outwardly to allow the sealing strip to exit as it is peeled away from the container (note Fig. 2). With regard to claim 7, Yamaguchi further discloses that the patch can contain two or more absorbable drugs if such is necessary for proper treatment (note lines 1-2 in col. 5) of the patient. With regard to claim 14, Yamaguchi et al. additionally disclose that release agent comprises a rupturing aid (constituted by notches 7) for broaching or removing a rupturable zone on the container 4 so as to provide an opening in the container 4 (note Fig. 1).

#### *Response to Arguments*

6. Applicant's arguments filed January 8, 2003 (Paper No. 11) have been fully considered but they are not deemed persuasive.

7. Regarding applicant's arguments with respect to the Yamaguchi reference, it is pointed out that the dispensing container, constituted by storage layer 4, is a discrete component (note lines 13-23 in col. 4).

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*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

10. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.



Kathleen J. Prunner:kjp

March 17, 2003

GREGORY HUSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700